

## REMARKS:

### Summary of Amendments to the Claims

Applicants have amended claim 1 to more particularly define the present invention. Claims 1 and 6 remain pending in the present application. No new matter has been added.

### Specification

The Examiner contended that the title of the invention was not descriptive and required a new title. As required by the Examiner, Applicants have amended the title to clearly indicate the invention to which the amended claims are directed.

### Claim Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 1 and 6 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,888,624 to Haghiri et al. ("Haghiri et al.") in view of U.S. Patent No. 5,290,068 to Gundjian ("Gundjian").

Applicants have amended claim 1 to clearly define the present invention as a method for increasing the identifiability of a watermark on a security sheet and increasing the durability of the security sheet. The present invention is directed to a new use of lacquer. Applicants respectfully submit that the claimed invention is not obvious from the cited prior art.

The present invention is directed to a method for increasing the identifiability of a watermark on a security sheet and increasing the durability of the security sheet, comprising the steps of: partially coating the printed security sheet with a layer of lacquer to the watermark, whereby the watermark is emphasized by increasing the transparency thereof; and lacquering the printed security sheet over its whole surface to increase the durability of the security sheet. Applicants have found that coating a watermark with a layer of lacquer increases the transparency of the watermark and therefore, the watermark is more clearly visible, due to the different transparencies of the watermark and its surrounding area. Thus, the watermark can be easily identified or recognized even without holding the sheet against a source of light.

Haghiri et al. teaches applying a protecting lacquer layer to the surfaces and edges of a multilayer IC-card, individual layers of which may include security elements such as watermarks, to provide protection and prevent the card edges from splitting. See column 9, lines 27-30 and 51-54. Haghiri et al. nowhere addresses the problem of low visibility or identifiability of watermarks on security sheets, let alone providing solutions to such a problem.

Gundjian teaches a method for securing paper against counterfeiting, photocopying and facsimile transmission. Gundjian teaches that ordinary printing or writing white paper is preprinted or coated with a layer of a colorless, color developer preferably integrated into a phenolic resin or other appropriate lacquer solution both for printing and for imparting potentially good paper surface finish. It further teaches that the lacquer or resin vehicle for the color developer makes it possible to simultaneously add gloss to the surface of the paper, since the specular reflection characteristics are found to be an important feature to enhance the uncopiability of the final product. See column 7, lines 15-26. Gundjian does not address the problem of low visibility or identifiability of watermarks on security sheets at all, let alone providing solutions to such a problem.

Pursuant to the mandate of 35 U.S.C. § 103, it is the invention as a whole that must be considered in obviousness determinations. See *In re Wright*, 6 USPQ 2d 1959, 1961 (Fed. Cir. 1988). The invention as a whole embraces not only the claimed structure or method, but also its properties and the problem it solves. *Id.* The problem solved by the invention is always relevant. *Id.* at 1962; see also *In re Benno*, 768 F.2d 1340, 1346, 226 USPQ 683, 687 (Fed. Cir. 1985) (“[applicant’s] problem” and the prior art “present different problems requiring different solutions”).

Here, Applicants respectfully submit that the Examiner’s position that the claimed invention is obvious in view of the references is not supported by the cited references. No reference shows or suggests the properties and results of Applicants’ claimed invention, or suggests the claimed combination as a solution to the problem of low visibility or identifiability of watermarks on security sheets. Instead, the cited Haghiri et al. and Gundjian references address different and unrelated problems - that of preventing splitting edges of IC-cards and counterfeiting of papers.

It is not pertinent whether Applicants' invention also has the prior art attributes of preventing splitting edges of IC-cards and counterfeiting of papers, Applicants' invention solves a different problem than the applied prior art, and such different problem is recited in the claims. Given the foregoing, the claimed invention is not rendered obvious by the applied prior art. Accordingly, Applicants respectfully submit that the rejections of claims 1 and 6 under 35 U.S.C. § 103(a) are overcome and withdrawal thereof is requested.

### Conclusion

Based on the foregoing amendments and remarks, favorable consideration and allowance of all of the claims now present in the application are respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be amended in formal respects in order to place the case in condition for allowance, then it is respectfully requested that such amendment be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

The Commissioner is authorized to charge any required fees, including any extension and/or excess claim fees, or credit any overpayment, to Goodwin Procter LLP Deposit Account No. 06-0923.

Respectfully submitted for Applicants,



Eva Tan (Reg. No. 46,406)  
GOODWIN PROCTER LLP  
103 Eisenhower Parkway  
Roseland, NJ 07068  
(973) 992-1990 Ext. 7904